

## REMARKS

Claims 1 - 24 are pending in the application and Claims 13 - 16 stand withdrawn subject to a restriction requirement. Claims 1 - 12 and 17 - 24 stand rejected and Claim 10 stands objected to. All rejections and objections are addressed below.

### **Restriction Requirement**

This application is subject to a two-way restriction requirement. Applicant hereby affirms the election of Claims 1-12 and 17-24, directed to the product decorative laminate. Claims 13-16 have been withdrawn from consideration and are hereby cancelled without prejudice to any subsequently filed divisional applications.

### **Claim Objection / Claim Rejections Under 35 USC 112, Second Paragraph**

Claims 1 and 10 have been amended to overcome the Claim objection and the Claim rejections under 35 USC 112, second paragraph. Claim 23 has been amended to provide antecedent basis for the phrase "the woven fiber material".

### **Rejections Under 35 USC 102(b) in view of Hoey '487**

Claims 1, 5, and 12 stand rejected as anticipated by Hoey '487. Hoey '487 recites that the embossable layer is a crushed, thermoset plastic foam. (Abstract) Claim 1 has been amended to recite that the embossable layer of the invented laminate is a non-foam layer. As a basis for the amendment, one of ordinary skill in the art would understand the specification to teach an embossable layer that is not a blown foam because the specification is silent with regard to any blowing agents and the described layer thicknesses (see page 8, lines 22-27; and the Example) are consistent with a non-foamed layer. For instance, the illustration of embossable layer 46 in Figure 2 clearly shows a non-foam resin layer and the use of a 5 mil embossable layer in the Example is indicative of a non-foam layer. Claims 5 and 12 each depend from Claim 1 and, thus, also recite the non-foam embossable layer.

Hoey '487 teaches away from the use of a non-foam embossable layer. Hoey teaches that "crushed foam is essential" (col. 2, line 42) and teaches layer thickness (10 to 150 mils) that are consistent with foam layers. In view of Hoey, one of ordinary skill in the art would not be

motivated to form a non-foam embossable layer as claimed, with a thickness of between 2.0 mils and 8.0 mils as specified on page 8 of the instant specification. Therefore, the claimed invention is novel and non-obvious in view of Hoey '487.

**Rejections Under 35 USC 102(b) in view of Gleim '671**

Claims 17, 18, 20, 22, and 24 stand rejected as anticipated by Gleim '671. Claim 17 recites a pigmented embossable layer wherein the pigmentation of the embossable layer has a color that matches at least one color of the ink layer. Claims 18, 20, 22, and 24 each depend from Claim 17 and, thus, also recite the pigmented embossable layer. Gleim '671 does not disclose a pigmented embossable layer wherein the pigment of the embossable layer matches the coloration of an ink layer.

Referring to Gleim, the Office Action states that "due to the transfer of ink or toner from the 'ink layer' to the 'embossable layer', the predominant color of the 'ink layer' will be the predominant color of the 'embossable layer'". Thus, the embossable layer of Gleim may be coated with ink or toner. However, Gleim does not disclose an embossable layer wherein the pigment of the embossable layer itself matches the coloration of the ink layer.

The coordination between the color of print ink and the color of embossable resin pigmentation is important to the function of the claimed invention. When the invented laminate is scratched or otherwise damaged, the exposed embossable layer masks the visible damage by blending with the coloration of the printed pattern. For instance, if the pigmented embossable layer were scratched through to half its thickness, the color of the exposed embossable layer would still match that of the printed pattern. None of the cited references address the problem of physical appearance upon damage to the respective laminates and the references, alone or in combination, do not disclose the use of a pigmented embossable resin having a color matching a color of the printed pattern.

**Rejections Under 35 USC 103 in view of Hoey '487 combined with Gleim '671**

Claims 2 – 4 have been rejected on the grounds that it would have been obvious to combine the ink layer from Gleim with the laminate of Hoey to create the claimed invention.

Claim 1, from which Claims 2 – 4 depend, has been amended to recite a non-foam embossable layer. Thus, even if the ink layer of Gleim were combined with Hoey (Hoey has a foamed embossable layer), Claims 2 – 4 would be distinguishable from the combination.

Claims 6 – 9 have been rejected on the grounds that the thickness of the laminate layers would have been obvious design choices given the teachings of Hoey and Gleim. Claims 19 and 21 have been rejected on the grounds that it would have been obvious to combine the fabric substrate layer of Hoey with the film laminate of Gleim.

The combination of references in this instance is improper because there is no motivation to combine the teachings of the Hoey and the Gleim references, and because the references teach away from one another. First, Hoey is based upon a fabric substrate (col. 1, lines 57-58). Fabric substrates are typically used to increase toughness and durability of the laminates. As mentioned above, Gleim teaches a laminate designed to retain texture or surface relief when the laminate is applied to a panel that requires substantial stretching (see col. 2, lines 17-20). The use of a fiber substrate is generally incompatible with the goals of obtaining a readily stretchable laminate. Therefore, one desiring the stretchable laminate of Gleim would not have looked to the unstretchable fabric based laminate of Hoey.

Second, the embossable layer of Hoey is a foam having an initial thickness of about 10 to 150 mils (col. 2, line 3). The thickness of the foam allows for substantial texture to be added to the embossable layer, suitable for the creation of simulated oil paintings described by Hoey (col. 1, lines 3-4). Conversely, Gleim teaches an embossable layer that is a thin film layer from 1 to 5 mils in thickness (col. 5, lines 36-41). The thin layer is capable of holding the relatively minor texturing required of a decorative laminate for use inside an airplane (col. 1, lines 10-21). Whereas the thin embossable layer of Gleim is unsuitable for creating the heavily textured “oil painted” surface desired by Hoey, and whereas the thick foamed embossable layer of Hoey is outside of the thickness ranges described by Gleim, one of ordinary skill in the art would not seek to combine the references.

All obviousness rejections in view of Hoey combined with Gleim should be withdrawn because there is no motivation to combine the references, and the references teach away from one another.

**Rejections Under 35 USC 103 in view of Hoey '487 combined with Piacente '160**

Claims 10 and 11 stand rejected under 35 USC 103 in view of Hoey combined with Piacente. Hoey and Piacente both disclose a foamed embossable layer. Claim 1, from which Claims 10 and 11 depend, has been amended to recite a non-foam embossable layer. Thus, even if the Hoey and Piacente references were combined, they would not result in the claimed invention. Thus, any rejection under Hoey combined with Piacente has been overcome.

**Rejections Under 35 USC 103 in view of Gleim '671 combined with Piacente '160**

Claim 23 is rejected under 35 USC 103 as obvious in view of Gleim combined with Piacente. The Office Action states that it would have been obvious to one of ordinary skill in the art to embed a woven material in a thermoplastic structural layer of Gleim as suggested by Piacente.

However, as mentioned above, fabric substrates such as those described in Piacente are typically used to increase toughness and durability of the laminates. As mentioned above, Gleim teaches that a laminate is desired to retain texture or surface relief when the laminate is applied to a panel that requires substantial stretching (see col. 2, lines 17-20). The use of a fabric substrate is generally incompatible with the goals of obtaining a readily stretchable laminate. Therefore, one desiring the stretchable laminate of Gleim would not have looked to the unstretchable fabric based laminate of Piacente.

Additionally, Piacente is a foamed laminate designed for use in inlaid floor coverings, with a preferred foam thickness of 30 mils to 60 mils (col. 4, line 57) and a preferred substrate thickness of 10 to 90 mils (col. 4, lines 19-22). The relatively large thicknesses are consistent with the use of the Piacente laminate as a flooring product. Gleim is a substantially thinner non-foamed laminate with an embossable layer of 1 mil to 5 mil and a substrate of 2.0 mil (col. 5, line 64). Because the Gleim laminate is about 10 times thinner than the Piacente laminate, one of ordinary skill in the art would not have substituted the thin Gleim embossable and protective layers upon the Piacente substrate in order to construct a flooring material.

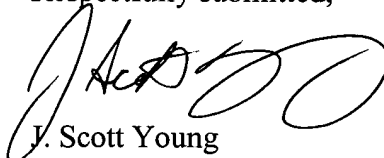
The obviousness rejection in view of Gleim combined with Piacente should be withdrawn because there is no motivation to combine the references, and the references teach away from one another.

**Conclusion**

In light of the amendments and remarks, it is submitted that the claims are in condition for allowance, and such action is respectfully requested.

It is not believed that extensions of time or fees for net addition of claims are required, beyond those that may otherwise be provided for in documents accompanying this paper. However, in the event that additional extensions of time are necessary to allow consideration of this paper, such extensions are hereby petitioned under 37 CFR § 1.136(a), and any fee required therefore (including fees for net addition of claims) is hereby authorized to be charged to Deposit Account No. 16-0605.

Respectfully submitted,

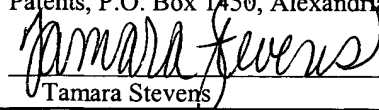


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Tamara Stevens

**Version with Markings to Show Changes Made:**

1. (Once Amended) A decorative laminate comprising:
  - a substrate layer comprising a woven fiber material;
  - an embossable layer disposed upon said substrate layer, said embossable layer comprising a non-foam pigmented embossable resin; and
  - a protective layer comprising a polyvinyl fluoride-based material positioned adjacent said embossable layer.
  
10. (Once Amended) The decorative laminate of Claim 1, wherein the embossable resin is selected from the group consisting of epoxies, polyesters, phenols, and combination thereof [(any more?)].
  
23. (Once Amended) The decorative laminate of Claim 17, further comprising a woven fiber substrate layer,  
wherein the embossable layer is disposed upon the substrate layer, and  
wherein the woven fiber material is embedded within a resin matrix.